

REMARKS

Applicant previously elected to prosecute Claims 1-15.

Specification Objection

The Examiner objected to the Specification for the following reason:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

**LIGHT EMITTING DEVICE HAVING LUMINOUS
COMPOUND INTERMIXING CLEAR EPOXY TO FILTER AND
COMBINE PREDETERMINED WAVELENGTHS**

Applicant has amended the title in accordance with the Examiner's suggestion.

Claim Rejection - 35 USC 112

In paragraph 4 of the Office Action, Examiner rejected Claim 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has canceled Claim 14.

Claim Rejection - 35 USC 102

Examiner rejected Claims 1-15 under 35 U.S.C. 102(b) as being anticipated by Hohn et al., U.S. Patent No. 6,066,861 ("Hohn"). Specifically, Examiner stated:

With respect to claim 1, Hohn teaches a light emitting device package as claimed including:

a semiconductor junction (1) operable to emit light when biased;

an homogenous composition (5) deposited on the semiconductor junction adapted to filter and combine predetermined wavelengths of light from the semiconductor surface. (See Figs. 1-5, col. 1, line 62-col. 7, line 34).

With respect to claim 2, insofar as the apparatus is concerned, the homogenous composition of Hahn comprises a mixture of a molding compound (5) and a luminous substance (6).

Product by process limitation:

The expressions "a sintered and palletized mixture of a molding compound and luminous substance" (as recited in claim 2); "is in palletized form prior to sintering and palletized" (as recited in claim 3); "is in powder form prior to sintering and pelletization" (as recited in claim 5); "is less than or equal to 5 microns in size prior to sintering and pelletization" as recited in claim 6); "is spherical or flake-like prior to sintering and pelletization" (as recited in claim 7); "incorporating a thixotropic agent to thicken the epoxy casting resin" (as recited in claim 9); and "before admixing and palletizing (as recited in claim 15) is/are taken to be a product by process limitation and is given no patentable weight. A product by process claim directed to the product per se, no inatter how actually made.

In re Hirao, 190 USPQ 15 at 17 (footnote 3). See *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974); *In re Marosi et al.*, 218 USPQ 289, 292 (Fed. Cir. 1983); *In re Brown*, 459, F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Plikington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935); and particularly *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process steps, which must be determined in a "product by process" claim, and not the patentability of the process. See also MPEP 2113. Moreover an old and obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

With respect to claim 3, insofar as the apparatus is concerned, the molding compound (5) of Hohn is formed.

With respect to claim 4, insofar as the apparatus is concerned, the molding compound (5) of Hohn comprises a clear epoxy.

With respect to claim 5, insofar as the apparatus is concerned, the luminous substance (6) of Hohn is in powder form.

With respect to claim 6, insofar as the apparatus is concerned, the luminous powder (6) of Hohn is less than or equal to 5 microns in size.

With respect to claim 7, insofar as the apparatus is concerned, the luminous powder (6) of Hohn is spherical or flake-like in shape.

With respect to claim 8, the molding compound (5) of Hohn comprises a clear epoxy.

With respect to claim 9, the clear epoxy (5) of Hohn further incorporating a thixotropic agent to thicken the epoxy casting resin.

With respect to claim 10, the luminous substance (6) of Hohn further comprises a Cerium doped garnet.

With respect to claim 11, the luminous substance (6) of Hohn further comprises YAG: Ce.

With respect to claim 12, the luminous substance (6) of Hohn having admixed a predetermined amount of mineral diffuser so as to optimize the luminous pattern of the composition.

With respect to claim 13, the mineral diffuser of Hohn comprises CaF_2 .

With respect to claim 14, as best understood by the examiner, the molding compound (5) and luminous substance (6) composition of Hohn further including a processing adjuvant.

With respect to claim 15, insofar as the apparatus is concerned, the LED package of Hohn further comprises a predetermined chromaticity of light based on the luminous powder's percentage by weight of the composition.

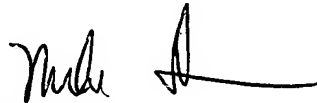
Applicant has amended Claims 1, 4, 6, 7, 8, 10 and 11 to overcome these rejections. Further, Applicant has canceled Claims 2, 3, 5, 9, 12, 13, 14 and 15.

Conclusion

Applicant respectfully submits that Claims 1, 4, 6, 7, 8, 10 and 11, now pending, are in condition for allowance. A Notice of Allowance is therefore requested.

If the Examiner has any other matters which pertain to this Application, the Examiner is encouraged to contact the undersigned to resolve these matters by Examiner's Amendment where possible. A Three (3) Month Extension of Time is included herewith, along with the required fee. If any additional fees are due, the commissioner is authorized to debit deposit account 50-1752.

Respectfully Submitted,



Michael Cameron
Registration No. 50,298

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Jackson Walker L.L.P.
2435 North Central Expressway, Suite 600
Richardson, TX 75080
Tel: (972) 744-2902
Fax: (972) 744-2909